

## REMARKS

The outstanding Official Action and cited art have been reviewed, and this application has been amended as believed appropriate. Per the examiner's requirement, the title of the application has been amended to more accurately reflect the invention claimed. Applicant requests withdrawal of the objection to the title.

A single clarifying correction has been made to the paragraph spanning pages 8 and 9 of the specification. The appropriateness of the change will be apparent from the drawings at the reference numeral 69.

Claim 1 has been amended to correct typographical errors. The periods ending lines 9 and 14 have been replaced by commas. Also, for clarity, "that proxy contact information" has been changed to "the proxy contact information" in line 19.

In claims 7 and 44, commas are changed to semicolons for consistency. Claim 12 is broadened slightly to refer to a "computer network" rather than the Internet. Claim 18, originally dependent from claim 12, has been made dependent from claim 16 and has been slightly broadened.

Claims 26, 45 and 46 have been amended to change "Web site" to "web site" for consistency. The dependency of claim 13 has been corrected. Claims 52 and 69 have been amended for clarity.

Claims 1 - 34, 44 - 47 and 52 - 70 are presently under examination in this application. Claims 1 - 34, 44 - 47 and 52 - 70 stand rejected as anticipated by the patent to Gardos et al., U.S. patent No. 6,880,007 (Gardos et al. '007) under 35 U.S.C. § 102(e). That rejection is respectfully traversed. No amendment to any claim is believed required to distinguish any claim from Gardos et al. '007. That patent is unrelated to the claimed invention.

### The Gardos et al. '007 Patent Does Not Relate to Proxy Registration

All of claims 1 - 34, 44 - 47 and 52 - 70 relate to proxy registration of a domain name. Claims 1 - 11 and 60 - 70 explicitly relate to a "proxy domain name registration system." See line 1 of each of independent claims 1, 60 and 69. Claims 12 - 18 relate to a "method of domain name registration" in which customers are offered a "choice of proxy registration of the domain names." See independent claim 12, line 5. Claims 19 - 25 expressly relate to a "method of

providing proxy registration of a domain name." See line 1 of independent claim 19. Claims 26 - 34 explicitly relate to a "domain name by proxy computer program." See line 1 of independent claim 26. Claims 44 - 47 are directed to "programming for a proxy entity domain name registration system." See independent claim 44, line 1. Claims 52 - 59 expressly relate to a "method for performing a proxy registration of a domain name for a customer." See independent claim 52, line 1.

The Gardos et al. '007 patent relates to a domain management system to be hosted by a registrar to allow its customers, i.e. registrants, to monitor and modify records relating to that registrant's domain name or names. See col. 4, lines 59 to 67. There is no mention of an entity (a proxy) standing in as registrant for a party that is the ultimate user of a domain name. That is what is described and claimed in the present application.

#### Claim 1 and Claims Dependent from Claim 1

In rejecting claim 1, the examiner states "Gardos et al. disclose a proxy domain name registration system (see abstract; and figures 1 - 3) ...." The abstract of Gardos et al. '007 makes it clear, however, that the patent does not relate to a proxy registration system. The Gardos et al. '007 abstract expressly states what that patent relates to:

A program running on a web server allows automated domain name registration, modification and management through an interface running on a client machine.

The "client machine" referred to is that of the user/registrant. As for Figs. 1 - 3 of the Gardos et al. '007 patent, the first two Figs. 1 and 2 relate to the conventional domain name registration arrangement and are included in the Gardos et al. '007 patent by way of background. There is no entity that can appropriately be called a proxy. Figs. 1 and 2 are shown in the patent as illustrating the history of domain name registration as described in the Background of the Invention. In Fig. 1 of Gardos et al. '007, the user's client machine is shown at 1. User is the registrant. Network Solutions, Inc. ("NSI") is shown acting in the capacity of registrar as well as registry manager for the .com, .org and .net domain names in 1992, an early point of time in the development of the Domain Name System ("DNS"). The Registry WHOIS 8 and DNS Root Servers 9 are shown under the control of the NSI. Registrants are able to register a name and

modify their records using NSI's user registration/modification program shown at 6. The only other entities in Fig. 1 are country code registries for those domain names ending in a highest level domain name that is a country abbreviation such as .de or .uk. These registries do not act as proxies for the user nor does NSI.

In Fig. 2, a later registration system in the evolution of DNS is shown. There the user/registrant, whose machine is again shown at 1, registers its domain name through a "unaccredited registrar." The unaccredited registrar communicates domain name requests and record changes from the user/registrant to NST, who otherwise acts as illustrated in Fig. 1. The unaccredited registrar does not serve as a proxy for the user/registrant. The Gardos et al. '007 patent nowhere suggests that.

As for Fig. 3 of Gardos et al. '007, this illustrates the arrangement proposed by the Gardos et al. '007 patent. Again the user/registrant's machine is shown at 1, facilities managed by an "accredited registrar" are within a first field set off in broken lines and a registry managed by NSI is within a second field set off in a second set of broken lines. Again there is no entity that serves as a proxy. There is no suggestion that a domain name registration by the user/registrant is not held by the user/registrant in its own name. The system shown in Fig. 3 and described in the specification of the Gardos et al. '007 patent is devoid of anything that could properly be regarded as a proxy.

In applying the claim terms of claim 1 to the Gardos et al. '007 patent, the examiner mistakenly states that the patent teaches "communicating a domain name and personal contact information to a proxy domain owner," but cites to no part of the patent drawings or specification in support of this assertion. However, the examiner's comparison goes on to show an error in the examiner's understanding of the Gardos et al. '007 system (and apparently the historical domain name registration systems of Figs. 1 and 2. The examiner equates the root server 9 to a proxy, stating "a proxy (DNS) (9) for receiving and storing personal contact information communicated to the proxy by the registrar, and communicating proxy personal contact information to the registrar ...." This is incorrect. Item 9 in Figs. 1, 2 and 3 of Gardos et al. '007 is the Domain Name System (DNS) Root Server. Col. 2, lines 54 - 57. The DNS Root Server is one of 13 installations worldwide that are "authoritative databases" of top-level domain names together with their corresponding IP addresses. Col. 2, lines 6 - 13. There is not any suggestion that the Root Servers 9 of the DNS could or should serve as a "proxy" standing in for the user/registrant

or that they could or should be used in any way other than has been conventional since the establishment of the DNS.

It is noted also that the outstanding Official Action refers to item 153 of Gardos et al. '007 as a "registrar." This too is incorrect. Item 153 is the registrar's WHOIS listing billing and contact information for that registrar's user/registrant customers. Col. 7, line 65 to col. 8, line 1.

The Official Action also refers to item 8 as a "registry." This also is incorrect as item 8 is the registry's WHOIS, listing contact information, etc. for domain names registered with the registry. Col. 2, lines 49 0 52 and 57 - 58.

Further, the DNS Root Server 9, which the Official Action incorrectly identifies as the "proxy," does not communicate "proxy personal contact information to the registrar," with "the registrar being responsive to the communication of personal contact information ... to submit a registration request and the proxy personal contact information from the proxy to a registry ...." The DNS Root Server is, in fact, a part of the registry. For it to act as contended in the Official Action, the registry would be sending information to the registrar only to receive back a domain name request from the registrar. The registry receives domain name registration requests from the registrar, but not based on any information it sends to the registrar. And nowhere in the Gardos et al. '007 patent is contact information exchanged among any installations of the Gardos et al. Fig. 3 suggested to be "proxy contact information."

The portions of the Gardos et al. '007 patent specification cited by the examiner in support of the rejection of claim 1, col. 6 lines 26 - 50, col. 7, lines 1 - 36, col. 7, line 57 to col. 8, line 25 and col. 8, line 52 to col. 9, line 29, have been reviewed. They do not make any suggestion of a proxy domain registration method, system or program.

Nothing in the Gardos et al. '007 patent can be correctly identified as claim 1's "proxy installation" with its "means for receiving and storing personal contact information communicated to the proxy installation by the registrar installation" and "means for communicating proxy personal contact information to the registrar.

Furthermore, no "registrar installation" of the Gardos et al. '007 patent is "responsive the communication of personal contact information by the proxy installation to ... submit a registration request and the proxy personal contact information from the proxy to a registry ...."

In the Gardos et al. '007 patent the registrar receives personal contact information from a customer (the would-be registrant) and submits it to a registry as is conventional. The rejection of claim 1 is in error and should be withdrawn.

Claims 2 and 3 are dependent claims incorporating the content of claim 1 by their dependency and are allowable with claim 1 for the reasons stated above. In the rejection of claims 2 and 3 the outstanding Official Action states:

As to claims 2-3, Gardos et al disclose that the proxy for enabling the customer to signal a command to cancel proxy registration and responding to the customer's signal of the command to cancel for automatically causing transfer of ownership to the customer by the registrar ....

However this is incorrect as there is no proxy installation in the Gardos et al. '007 patent, there is no proxy registration to be cancelled as set forth in claim 2 and there is no automatic ownership transfer as set forth in claim 3.

The specification portions cited in support of the rejection of claims 2 and 3 were reviewed. They do not contain anything that can accurately be pointed to as anticipating the proxy installation provisions of claims 2 and 3. Allowance of these claims is appropriate at this time.

Regarding claims 4 - 6, these claims are dependent and include the provisions of claim 1 discussed above and missing from the Gardos et al. '007 patent. For this reason claims 4 - 6 are patentable over the Gardos et al. '007 patent.

Neither do the provisions of the Gardos et al. '007 that are mistakenly identified as the proxy in the Official Action pass email to the customer (claim 4), or block one or more categories of email (claim 5) including SPAM, unauthorized bulk mail, unauthorized commercial mail or pornography (claim 6).

The portions of the relied-upon Gardos et al. '007 patent cited to support the rejection of claims 4 - 6 have been reviewed. However, none relates to a proxy installation, let alone to a proxy installation with the features of claims 4 - 6. Allowance of these claims presently is appropriate.

Claim 7 and Claims Dependent from Claim 7

Claim 7 is an independent claim to a "proxy domain registration system" The claim sets forth, among other claim elements, a proxy computer installation. The Gardos et al. '007 patent has no proxy computer installation. The rejection of claim 7 incorporates the examiner's application of the relied upon Gardos et al. '007 patent to claims 1 - 6. These, however, are in error, as pointed out in detail above. Claim 7 includes a registrar computer installation that establishes a website with a page having a field "prompting a customer to indicate whether proxy registration is desired." The cited portions of the Gardos et al. '007 patent, Fig. 4A, col. 8, line 52 to col. 9, line 29, and col. 9, line 66 to col. 10, line 51, do not contain a disclosure of any such feature. Claim 7 is patentable over the relied-upon Gardos et al. '007 patent and all other art of record and should be allowed at this time.

Claims 8 - 11 are dependent claims that incorporate by their dependency the provisions of claim 7, and so are likewise patentable over the Gardos et al. '007 patent. Claims 8 - 11 set forth additional features of a proxy installation that appear nowhere in the Gardos et al. '007 patent and are patentable over that patent for this reason as well.

It should be noted that, in the rejection of claims 7 - 11, the Official Action refers to Figs. 4A and 4B as pages of a proxy website when in fact they are pages from a registrar's website. Also, again the portions of the relied-upon patent cited in support of the rejections of claims 7 - 11 have been reviewed, but they teach nothing relating to a proxy installation or its website.

The rejection of claims 7 - 11 ends with a cite that references a Fig. 4S. This is believed to be a typographical error, so if this rejection is not withdrawn, as is believed appropriate, clarification is requested.

Claim 12 and Claims Dependent from Claim 12

Method claim 12 is an independent claim. In rejecting this and dependent claims 13 - 18, the examiner incorporates the reasons for rejecting claims 1 - 16 treated in detail above. Claim 12 claims the method of domain name registration that includes offering customers a choice of proxy registration, forwarding domain names and customer information to a proxy, receiving proxy contact information from a proxy and providing contact information to the registry. For the Gardos et al. '007 patent to contemplate these steps four parties would be necessary, the

customer, the registrar, the proxy and the registry. Gardos et al. have only the customer, the registrar and the registry - no proxy. The arrangement set out in Gardos et al. '007 cannot operate to perform the steps of method claim 12 or the dependent method claims 13 - 18.

Claim 19 and Claims Dependent from Claim 19

Claims 19 - 25 are method claims relating to proxy installation operation. Claim 19 is independent. Claims 20 to 25 are dependent. Claim 19 includes the step of receiving from a registrar a request to take ownership of a domain name registration as a proxy. Nowhere in the Gardos et al. '007 patent does an entity receive a request to act as a proxy as set out in claim 19.

Claim 19 further recites the proxy's receipt of customer information for a registrar's customer that seeks proxy registration, sending to the registrar the contact information for the proxy and storing the customer contact information. This series of steps is not performed by the system of the Gardos et al. '007 patent since no installation or entity in the Gardos patent acts as a proxy. Claim 19 and claims 20 to 25, dependent from claim 25, are clearly patentable over the relied-upon Gardos et al. '007 patent and should be allowed at this time.

Once again the portion of the Gardos et al. '007 patent to which the examiner cites in support for the rejection of claims 19 to 25 has been reviewed, but it does not relate to proxy establishment or operation of a proxy installation at al. That portion of the patent, col. 9, line 48 to col. 10, line 17, thus does not support the outstanding rejection.

Claim 26 and Claims Dependent from Claim 26

Independent claim 26 and claims 27 to 34 dependent therefrom relate to programming for proxy registration. Claim 26, unlike Gardos et al. '007, sets forth a web site defining programming "offering to the customer at the web site a registration by proxy option." Although the outstanding Official Action states that Gardos et al. '007 programming does this, applicants respectfully submit that nothing in the Gardos et al. '007 patent provides such an option.

Claim 26, which claims the programming that operates at the registrar's installation, also calls for a communication program for communicating with a proxy and a communication program for communicating with a registry. Even if the mistaken identification of a proxy in the rejection of claim 1 were correct, the programming would not have these two communications programs since what the Official Action identifies initially as the proxy, the root server, is

actually a part of the registry. Even misreading the Gardos et al. '007 patent the terms of claim 26 could not be met.

Claims 27 - 34 are patentable with claim 26 and for patentable content therein in addition. Allowance of claims 26 to 34 at this time is appropriate. Again the portions of the relied-upon patent cited in the rejection of claims 27 - 34 have been reviewed, but they do not support the rejection.

#### Claim 44 and Claims Dependent from Claim 44

Claims 44 to 47 relate to "programming for a proxy entity." These are said to be rejected "for the same reasons set forth to rejecting claims 1 - 11 ...." However as shown above the rejections of claims 1 - 11 are in error. The same is true of the rejection of claims 44 to 47. In the relied-upon Gardos et al. '007 patent there is no proxy entity, consequently there is no proxy entity programming.

Claim 44 is independent and claims 45 - 47 are dependent from claim 44. All are allowable over the Gardos et al. '007 patent which has no programming "for a proxy entity," no communications programming enabling a computer to receive "a request for proxy domain name registrant information," no "customer information for a customer that has requested proxy domain name registration ..." nor "further communications programming enabling the computer to send to a registrar" the "proxy information to be used in registering a domain name in the name of the proxy."

By virtue of their dependency from claim 44 and for their inclusion of further proxy features not present in the relied-upon Gardos et al. '007 patent, claims 45 to 47 are patentable over Gardos et al. '007.

#### Claim 52 and Claims Dependent from Claim 52

Claims 52 to 59 relate to the method of proxy registration. The Official Action states that these claims are rejected on the same grounds as claims 1 - 6 and 26 - 34. Those grounds are erroneous, however, for the reasons set out above and those grounds are similarly erroneous as applied to claims 52 to 59.

Claim 52 is an independent method claim and claims, *inter alia*, storing customer personal information that is "not made public" and "registering the domain name with a registry

using proxy information" that is made public. Nothing in the Gardos et al. '007 patent corresponds to these steps and, as previously stated, that patent does not bear any relation to proxy registration of a domain name.

Even if the root server 9 of Gardos et al. '007 is called a "proxy," which is incorrect, the terms of claim 52 are not met by Gardos et al. Claim 52 is allowable over Gardos et al. '007 and claims 53 to 59 are allowable by their dependency. Figs. 4A-4B and col. 8, line 52 to col. 10, line 63 of Gardos et al. '007 have nothing to do with registration of a domain name in the name of a proxy.

#### Claims 69 and 70

Claims 69 and 70 are said to be rejected for the same reasons as claims 7 and 8. However, as discussed above, the rejection of claims 7 and 8 in the Official Action is in error. As previously stated nothing in the Gardos et al. '007 patent teaches a message prompting a customer to "indicate whether proxy registration is desired," or a database storing "in association with customer information at least one domain name and the proxy information ...." Claim 69 is not anticipated by Gardos et al. '007, nor is claim 70, which is dependent from claim 69. These should now be allowed.

#### New claims

New claims 71 - 95 include by their dependencies the content of the claims discussed above. These claims are clearly patentable by virtue of their dependency irrespective of additional patentable recitations as may be present.

All claims currently present in this application are believed allowable over all of the art of record and prompt further examination of the application and its allowance are respectfully requested.

Any questions or suggestions regarding the application or the amended claims submitted herewith should be directed to the undersigned attorneys for applicant at the telephone number listed below or by email to the email address listed below.

Respectfully submitted,

**GALLAGHER & KENNEDY, P.A.**

Date: August 29, 2005

By: 

Thomas D. MacBlain  
Reg. No. 24,583  
Kaare D. Larson  
Reg. No. 51,920  
Attorneys for Applicant

Gallagher & Kennedy, P.A.  
2575 East Camelback Road  
Phoenix, AZ 85016  
(602) 530-8088  
[tdm@gknet.com](mailto:tdm@gknet.com)